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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,237	04/03/2001	Kimitaka Murashita	1075.1154 (JDH)	1240

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EXAMINER	
DIXON, THOMAS A	

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/824,237	MURASHITA ET AL.	
	Examiner	Art Unit	
	Thomas A. Dixon	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) *21,22 and 29-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election without traverse of Group 1 in the reply filed on 5/31/05 is acknowledged.

Claim Rejections - 35 USC § 112 1st Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification, claims and drawings should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

pg 1, line 13, the word "gichet" is unclear, and could not be found in the dictionary;
pg 4 paragraph (2-5) is unclear;
throughout the specification, claims and drawings, the word "situation" follows the words "service" and "reservation" and appears to be related to the Japanese language translation, but is unclear.
Appropriate correction is required.

Claim Rejections - 35 USC § 112 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20, 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

the terms "store/facility", "start/end time", and "discount/value-added" are indefinite.

the terms "service situation", utilization situation and "reservation situation" are indefinite.

the terms "performing event information" and "other reservation server" are indefinite.

the phrase "whether or not it is possible" are indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-20, 23-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

5. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

6. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

7. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State*

Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

9. In the present application, Apparatus Claims 1-20,23-24, to systems and a user terminal, contain no structure and is not statutory.

Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-2, 7-8, 17-18, 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Visconti (6,876,973).

As per Claim 1.
Visconti ('937) discloses:
a retaining section, see abstract (network with database of restaurants and restaurant database of tables);
an alternative event information outputting section, see abstract, lines 9-15;
a receiving section, see abstract, lines 7-8;
a reservation managing section, see abstract, line 12;
a transmitting section, see abstract, lines 9-15.

As per Claim 2.
Visconti ('937) discloses:
a retaining section, see abstract (network with database of restaurants and restaurant database of tables);
an alternative event information outputting section, see abstract, lines 9-15;
a receiving section, see abstract, lines 7-8;
a reservation managing section, see abstract, line 12;
a transmitting section, see abstract, lines 9-15.

As per Claims 7, 8.
Visconti ('937) further discloses an other reservation notifying section for outputting, to said transmitting section, a reservation situation on a reservation-needed event requiring reservation, among said alternative event outputted from said alternative event information outputted from said alternative event information outputting section, see abstract, lines 15-19.

As per Claim 17.
Visconti ('937) further discloses:
an other reservation server interface section to output, as said alternative event information, other reservation server alternative event information retained in an other reservation server connected through a network server, and said other reservation situation notifying section is made to extract practicable other reservation server alternative event information, said other reservation server alternative event information satisfying a predetermined condition from said other reservation server alternative event information outputted from said other reservation server interface section, and to output the extracted practicable other reservation server alternative event information to said transmitting section, see column 3, lines 44-65.

As per Claim 18.

Visconti ('937) further discloses a mediating section for transmitting a reservation request from a user, received in said receiving section to said other reservation server through said other reservation server interface section, see column 3, lines 44-65

As per Claim 23.
Visconti ('937) discloses:
a receiving section, see abstract, lines 7-8;
a displaying section, see abstract, lines 9-15;
a selecting section, see abstract, lines 4-8;
a transmitting section, see abstract, lines 9-15.

As per Claims 20, 24.
Visconti ('937) further discloses value added information, see column 9, lines 15-19.

As per Claim 25.
Visconti ('937) discloses:
a reservation server, see column 6, lines 8-10;
a retaining section, see abstract (network with database of restaurants and restaurant database of tables);
an alternative event information outputting section, see abstract, lines 9-15;
a first receiving section, see abstract, lines 7-8;
a reservation managing section, see abstract, line 12;
a first transmitting section, see abstract, lines 9-15;
a second receiving section, see abstract, lines 9-15;
a displaying section, see abstract, lines 9-15;
a selecting section, see abstract, lines 4-8;
a second transmitting section, see abstract, lines 9-15.

As per Claim 26.
Visconti ('937) discloses:
a first transmitting step in which a reservation server transmits , to a user terminal connected through a radio network to said reservation server, at least one of store/facility information including a reservation-needed service requiring reservation and a reservation situation of said reservation needed service and alternative event information on an event substituting for said reservation-needed service, see abstract, lines 9-15 and column 5, lines 57-65;
a reserving step in which said user terminal transmits, to said reservation server, a desired service or desired event which a user desires, among said store/facility information or alternative event information transmitted in said first transmitting step, see abstract, lines 9-15;
a selecting step in which said reservation server selects at least one of said store/facility information and said event substituting for said reservation-needed service,

on the basis of the desired service or desired event transmitted in said reserving said step, see abstract, lines 4-8;

a second transmitting step in which said reservation server transmits, to said user terminal, said store/facility information or alternative information selected by said selecting step, see abstract, lines 9-15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 3-6, 9-12, 15-16, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Visconti (6,876,973) in view of Waytena et al (5,978,770).

As per Claims 3, 4.

Visconti ('937) does not specifically disclose:

a waiting time calculating section for calculating, as a waiting time, a difference between a start time, included in said alternative event information selected by said reservation managing section, or a reservation-needed service start time, included in said store/facility information selected by said reservation managing section and the present time, and for outputting the calculated waiting time.

Waytena et al ('770) teaches a waiting time calculator, see figure 7, for determining the status of a pending reservation or giving information regarding wait time for an attraction for the benefit of allowing the user to fit it into the itinerary.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator for the benefit of allowing the user to fit it into the itinerary.

As per Claims 5, 6.

Visconti ('937) does not specifically disclose:

an end time calculating section for calculating, as an end time, the sum of performance time to be taken for said event, included in said alternative event information selected by said reservation managing section, or a performance time to be taken for said reservation-needed service, included in said store/facility information selected by said reservation managing section, the present time and for outputting the calculated end time.

Waytena et al ('770) teaches a performing event, see figure 5A (shows) and a waiting time calculator with end time, see figure 7 (VQthroughput), for determining the status of a pending reservation or giving information regarding wait time for an attraction for the benefit of allowing the user to fit it into the itinerary.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator with end time and a performing event for the benefit of allowing the user to fit it into the itinerary.

As per Claims 9, 10.

Visconti ('937) does not specifically disclose a performing event information.

Waytena et al ('770) teaches a performing event, see figure 5A (shows) and a waiting time calculator, see figure 7, for determining the status of a pending reservation or giving information regarding wait time for an attraction for the benefit of allowing the user to fit it into the itinerary.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator and a performing event for the benefit of allowing the user to fit it into the itinerary.

As per Claims 11, 12.

Visconti ('937) does not specifically disclose selection is made based on travel time.

Waytena et al ('770) teaches a performing event, see figure 5A (shows) and a time calculator which takes travel time into account, see figure 7 (710), for determining the status of a pending reservation or giving information regarding wait time for an attraction for the benefit of allowing the user to fit it into the itinerary.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator and a performing event for the benefit of allowing the user to fit it into the itinerary.

As per Claims 15, 16.

Visconti ('937) further discloses to retain information according to time zone, see column 3, lines48-50, but does not specifically disclose selection is made based on travel time.

Waytena et al ('770) teaches a performing event, see figure 5A (shows) and a time calculator which takes travel time into account, see figure 7 (710), for determining the status of a pending reservation or giving information regarding wait time for an attraction for the benefit of allowing the user to fit it into the itinerary.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator and a performing event for the benefit of allowing the user to fit it into the itinerary.

As per Claim 27.

Visconti ('937) further discloses another reservation server, see column 5, lines 44-65.

Visconti ('937) does not specifically disclose:

a performing event information extracting step in which said server extracts from said other reservation server alternative event information accessed in the other reservation server access step, performing event information practicable within a user's waiting time to be taken until a desired service starts; and

performing event information transmitting step in which said reservation server transmits, to said user terminal, said performing event information extracted in said performing event extracting step.

Waytena et al ('770) teaches a performing event, see figure 5A (shows) and a waiting time calculator, see figure 7, for determining the status of a pending reservation or giving information regarding wait time for an attraction for the benefit of allowing the user to fit it into the itinerary.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator and a performing event for the benefit of allowing the user to fit it into the itinerary.

As per Claim 28.

Visconti ('937) further discloses another reservation server, see column 5, lines 44-65.

Visconti ('937) does not specifically disclose:

an other reservation server access step in which said reservation server gains access to the other reservation server store/facility information or other reservation server alternative event information retained in an other reservation server connected through a server network to said reservation server;

a waiting time calculating step in which said reservation server calculates a user's waiting time, to be taken until a desired service or a desired event starts, on the basis of said other reservation server store/facility information or other reservation server alternative event information accessed in said other reservation server access step; and

an extracting step in which said reservation server extracts, from the desired service or the desired event a service or event practicable within the waiting time calculated in said waiting time calculating step.

Waytena et al ('770) teaches a performing event, see figure 5A (shows) and a waiting time calculator, see figure 7, for determining the status of a pending reservation or giving information regarding wait time for an attraction for the benefit of allowing the user to fit it into the itinerary.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator and a performing event for the benefit of allowing the user to fit it into the itinerary.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Visconti (6,876,973) in view of Graber et al (5,712,979) or Rossides (5,359,508).

As per Claim 19.

Visconti ('937) further discloses another reservation server, see column 5, lines 44-65.

Visconti ('937) does not specifically disclose:

a utilization situation retaining section for retaining an access log between said reservation server and said other reservation server, with said utilization situation retaining section being made to calculate an introduction charge on information provided by said other reservation server to said reservation server and an introduction charge on information provided from said reservation server to said other reservation server on the basis of said access log, and to retain both the calculated introduction charges.

Graber et al ('979) and Rossides ('508) teach a system for monitoring web site navigation and paying for referrals, see abstract and figure 7 (740-770) of Graber et al ('979) and abstract and figure 1 (7) for the benefit of rewarding participation in the system.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to retain an access log, calculate a charge and store the charges as taught by Graber et al ('979) and Rossides ('508) for the benefit of rewarding participation in the system.

Allowable Subject Matter

13. Claims 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art Made of Record

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yokomura (JP 11250155) discloses a reservation that gives alternatives when a "reservation is impossible" situation occurs.

MacArthur teaches restaurants providing entertainment (performance) to occupy patrons during wait time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas A. Dixon
Primary Examiner
Art Unit 3639

July 05